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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,710	08/28/2001	Eiji Ueda	50023-147	2737

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MCDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

NGUYEN, QUANG N

ART UNIT PAPER NUMBER

2141

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/939,710

Applicant(s)

UEDA, EIJI

Examiner

Quang N Nguyen

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. This Office Action is in response to the Application SN 09/939,710 filed on 08/28/2001. Claims 1-14 are presented for examination.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the submitted drawings are illustrated in Japanese language that the Examiner won't be able to understand.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. **Claims 1-4, 7-9 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Mandalia (US 6,636,890).**

5. As to claim 1, Mandalia teaches a system and method for delivering email messages over a broadcasting distribution network, comprising a parent station (*not*

shown) and relay centers (cable TV substations 32 as illustrated in Fig. 1) for relaying broadcasting program data to parts of districts, wherein the relay center is provided with multiplexing means (a signal mixer 42 for receiving a satellite feed 44 and a cable feed 46 and also input signal from the Internet 28 through an Internet mail processor 50 and modulator 52 as illustrated in Fig. 2) for multiplexing email data addressed to a terminal in a relay area of the relay center with the broadcasting program data (Mandalia, Figs. 1-2, C3:L35 - C4:L2 and C4: L42-50).

6. As to claim 2, Mandalia teaches the broadcasting system of claim 1, wherein the relay area includes the number of terminals to which the email data can be delivered within a specific time *(since the cable TV substation 32 serves a finite number of registered subscribers of a town/city whose subscriber ID is stored in a table and associated with the received emails which can be delivered within a specific time)* (Mandalia, C3: L37-47 and C4: L42-50).

7. As to claim 3, Mandalia teaches the broadcasting system of claim 1, wherein each relay center has respective domain parts different from each other *(inherently, every cable TV substation 32 serves a particular town/city or a certain number of registered subscribers).*

8. As to claim 4, Mandalia teaches the broadcasting system of claim 1, which further comprising:

mail receiving means for receiving email data addressed to the terminal *(the email server accepting/receiving an email message addressed to an email subscriber of the cable TV distribution network)* (Mandalia, C1: L49-64);

position management means for acquiring position information of a terminal to which the email data received by the mail receiving means is to be transmitted *(the email server maintaining a table of subscribers identifying data for people who are served by the cable TV substation)*;

relay center selecting means for selecting relay center corresponding to the position information acquired by the position management means *(the email server selecting the cable TV substation that serves the registered subscribers associated with the received emails)*; and

mail sending means for sending the email data received by the mail receiving means to the relay center selected by the relay center selecting means *(the mail server picks all email for the area served and sends the email to the selected TV cable substation to broadcast all the email to each of the subscribers)* (Mandalia, C3: L36-47).

9. Claims 7-8 are corresponding method claims of broadcast system claims 1-2; therefore, they are rejected under the same rationale.

10. Claim 9 is a corresponding email integrated server claim of broadcast system claim 4; therefore, it is rejected under the same rationale.

11. As to claim 12, Mandalia teaches a system and method for multiplexing the broadcasting program data with the email data and then delivering the multiplexed data, which comprising:

receiving the broadcasting program data from the parent station *(a signal mixer 42 of the cable TV substation 32 receiving the broadcasting program data from a satellite feed 44 and a cable feed 46 as illustrated in Fig. 2);*

multiplexing the email data addressed to a terminal included in the relay area of parts of districts to which the broadcasting data is broadcasted and the broadcasting program data received in the above step of receiving the broadcasting program data *(the signal mixer 42 also receiving email data addressed to a terminal served by the cable TV substation 32 from the Internet 28 through an Internet mail processor 50 and modulator 52 as illustrated in Fig. 2);* and

delivering to the relay area the broadcasting program data multiplexed with the email data in the above step *(transmitting the email message and address header for transmission over the cable distribution network simultaneously with television signals)* (Mandalia, Figs. 1-2, C1: L49-64, C3:L35 - C4:L2 and C4: L42-50).

12. Claims 13-14 are corresponding program and computer-readable storage medium claims of method claim 12; therefore, they are rejected under the same rationale.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 5-6 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mandalia, in view of Lee et al. (US 6,212,553), herein after referred as Lee.

15. As to claims 5-6, Mandalia teaches the broadcast system of claim 4, but does not explicitly teach transmitting the email data on the basis of a mail receiving flag representing whether the email data should be transmitted by means of the broadcasting or not, wherein the mail receiving flag could be changed on the basis of the instruction of user.

In a related art, Lee teaches a system and method for sending and receiving flags and associated data in email transmission, wherein a user (*sender or recipient*) is allowed to attach a flag, or message flag, to an email message (*i.e., the message flag could be changed on the basis of the instruction of user*) identifying the follow-up action, or action item, that is required to deal with the message (*i.e., whether the email data should be transmitted by means of the broadcasting or not*), and may also include a deadline (Lee, C20: L58-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Mandalia and Lee to include a mail receiving flag representing whether the email data should be transmitted by means of the broadcasting or not, wherein the mail receiving flag could be changed on the basis of the instruction of user since such methods were conventionally employed in the art to allow the user to flag messages that draw the recipient's attention to the main action item associated with the message which may require follow-up action.

16. Claims 10-11 are corresponding email integrated server claims of broadcast system claims 5-6; therefore, they are rejected under the same rationale.


17. Further references of interest are cited on Form PTO-892, which is an attachment to this office action.

18. A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER